

Appl. No. : 10/021,797
Filed : December 11, 2001

Remarks

In response to the Office Action mailed April 4, 2003, Applicant respectfully requests the Examiner to reconsider the above-captioned application in view of the foregoing amendments and the following comments. As a result of the amendments listed above, Claims 1 and 3-13 remain pending. Claims 1 and 3-5 have been amended, and new Claims 7-13 have been added. Claim 2 has been cancelled without prejudice or disclaimer.

In the Office Action mailed April 4, 2003, the Examiner rejected Claims 1-3 under 35 U.S.C. § 102(b) as being anticipated by Laguette et al., USP 6,478,821 (hereinafter, "Laguette"), and rejected Claim 5 under 35 U.S.C. § 103(a) as being obvious over Laguette in view of Turley, USP 4,892,543 (hereinafter, "Turley"). The Examiner objected to Claim 4, but indicated that the claim would be allowable if rewritten in independent form.

Rejections for Anticipation

The Examiner rejected Claims 1-3 under 35 U.S.C. § 102(b)* as being anticipated by Laguette. However, independent Claim 1 has been amended as follows:

1. (CURRENTLY AMENDED) An intraocular lens having an optical axis, said intraocular lens comprising:
a first optic; and
first and second translation members extending from said first optic, said translation members comprised of a shape memory material, said translation members permitting said first optic to translate substantially along said optical axis, upon implantation of said lens in an eye and in response to a force by the ciliary muscle of the eye.

Applicant respectfully submits that Laguette fails to teach or suggest, and in fact teaches away from, the combination of features recited in amended Claim 1. In particular, Laguette fails to disclose "translation members" which "[permit the] first optic to translate substantially along [the] optical axis ... in response to a force by the ciliary muscle of the eye." Laguette instead teaches "fixation members" 118/218/318/418/518. According to Laguette:

* Laguette's date of issuance (November 12, 2002) falls after the filing date of the present application, and after the filing dates of the provisional applications of which benefit is claimed in the present application. Laguette is therefore unavailable as prior art to the present application under 35 U.S.C. § 102(b). Laguette is nonetheless prima facie prior art to this application under §§ 102(a) and/or 102(e). However, Laguette does not anticipate the present claims, as is demonstrated herein.

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The fixation members 118 preferably are flexible yet sufficiently strong and resilient to hold the optic 112 in place yet permit the fixation members to flex in response to iris 28 movement ... [t]he fixation members 118 preferably are designed to flex so as to restrict or substantially eliminate movement of the optic 112 in the direction of the optical axis 150.

See Laguette at col. 6, ll. 24-27, 32-35. Accordingly, Laguette teaches against modifying his disclosed IOL to include the "translation members" recited in amended Claim 1.

For at least these reasons, Applicant respectfully submits that amended Claim 1 is in condition for allowance over the prior art of record.

Dependent Claims

As demonstrated above, independent Claim 1 is believed to be in condition for allowance over the prior art of record. Dependent Claims 3 and 5-8 (Claims 7-8 being new claims) are also believed to be in condition for allowance, by virtue of their dependence from allowable base claims as well as their recitation of further novel and unobvious combinations of features.

Allowable Subject Matter

The Examiner indicated that Claim 4 would be allowable if rewritten in independent form. Applicant has so rewritten Claim 4, and therefore respectfully submits that this claim is in condition for allowance.

New Claims

Applicant submits herein new Claims 9-13, which are believed to be allowable over the prior art of record.

Form PTO-1449

The Examiner enclosed with the outstanding Office Action a copy of a Form PTO-1449 that Applicant filed with an Information Disclosure Statement on April 19, 2002. The Examiner initialed all of the references on this Form PTO-1449, except the references listed in the sections titled "Foreign Patent Documents" and "Other Documents." Applicant respectfully requests that

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the Examiner consider (if she has not already) these non-initialed references and provide a copy of this Form PTO-1449 with all references initialed.

Second Supplemental Information Disclosure Statement

Applicant directs the Examiner's attention to the Second Supplemental Information Disclosure Statement filed on March 25, 2003, a few days before the mailing date of the present Office Action. Applicant respectfully requests that the Examiner consider the references cited in the Second Supplemental Information Disclosure Statement when examining the claims now pending in this application. No fees are believed due, but in the event that Applicant must pay any fees in connection with the Second Supplemental Information Disclosure Statement, the Commissioner is authorized to charge any such fees to Deposit Account 11-1410.

Third Supplemental Information Disclosure Statement

Applicant submits herewith a Third Supplemental Information Disclosure Statement, citing a number of additional references for the Examiner's consideration. The Statement is accompanied by the fee set forth in 37 C.F.R. § 1.17(p).

Conclusion

For the foregoing reasons, it is respectfully submitted that the rejections set forth in the outstanding Office Action are inapplicable to the present claims. Accordingly, issuance of a Notice of Allowance is most earnestly solicited.

Applicant respectfully traverses each of the Examiner's rejections and each of the Examiner's assertions regarding what the prior art shows or teaches. Although amendments, deletions and cancellations have been made, no acquiescence or estoppel is or should be implied thereby. Rather, the amendments, deletions and cancellations are made only to expedite prosecution of the present application, and without prejudice to presentation or assertion, in the future, of claims on the subject matter affected thereby. Any arguments in support of patentability and based on a portion of a claim should not be taken as founding patentability solely on the portion in question; rather, it is the combination of features or acts recited in a claim which distinguishes it over the prior art.

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The undersigned has made a good faith effort to respond to all of the rejections in the case and to place the claims in condition for immediate allowance. Nevertheless, if any undeveloped issues remain or if any issues require clarification, the Examiner is respectfully requested to call Applicant's attorney, Mark J. Kertz at (949) 721-6318 to resolve such issue(s) promptly.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: Aug. 1, 2003

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